REMARKS

In the non-final Office Action, the Examiner objects to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(4); objects to claims 9, 30 and 44 for minor informalities; rejects claim 42 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; rejects claims 1, 13-17, 21, 22, 34-38, 47 and 50 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON (U.S. Patent No. 5,634,051) in view of non-patent document entitled "How to Interpret your Search Results" (GOOGLE1); rejects claims 2, 3, 23, 24, 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, further in view of BAXTER et al. (U.S. Patent Application Publication No. 2003/0229637); rejects claims 4-9 and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view GOOGLE1, and further in view of SMITH (U.S. Patent No. 6,502,076); rejects claims 10, 31 and 42 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of MITCHELL et al. (U.S. Patent No. 5,963,966); rejects claims 11, 12, 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, in view of MITCHELL et al., and further in view of BAXTER et al.; rejects claims 18 and 39 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of CRAGUN et al. (U.S. Patent No. 5,832,212); rejects claims 19 and 40 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view non-patent document entitled "Google Search Technology" (GOOGLE2); rejects claims 20 and 41 under 35

U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of KINCAID et al. (U.S. Patent No. 6,920,448); rejects claims 43 and 45 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of BAXTER et al.; and rejects claims 44 and 46 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of BAXTER et al., and further in view of GOOGLE1. Applicant respectfully traverses these rejections.

Claims 1-50 were pending in the present application prior to the above amendments. Claims 25, 29, 44-46, and 50 have been canceled without prejudice or disclaimer and claims 1, 3, 9, 16-22, 26-28, 30, and 37-43 have been amended to improve form. No new matter has been added by way of the present amendments. Accordingly, claims 1-24, 26-28, 30-43, and 47-49 are now pending. Reconsideration and allowance of all claims in view of the following remarks are respectfully requested.

Objections to the Drawings

The Examiner objects to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(4) because the reference characters "210" and "110" have both been used to designate the document title. Subject to approval by the Examiner, Applicant proposes amending Fig. 2B to replace numeral 110 with numeral 210, thereby numbering the drawings to be consistent with the specification. Applicant respectfully requests that the Examiner enter the proposed drawing correction and withdraw the objection to the drawings.

Claim Objections

The Examiner objects to claims 9, 30, and 44 for minor informalities. More specifically, the Examiner objected to claims 9 and 30 for failing to include an "and" or an "or" prior to the last entry in a claimed listing. Additionally, the Examiner objected to claim 44 for erroneously claiming dependency from claim 45, rather than claim 43. Claims 9, 30, and 44 have been amended in the manner suggested by the Examiner to overcome the noted objections. Accordingly, reconsideration and withdrawal of the claim objections are respectfully requested.

Rejections under 35 U.S.C. §112

The Examiner rejects claim 42 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner indicated that the language "another electronic version" in claim 42 is unclear, since no first instance of an electronic version has been claimed. Accordingly, claim 42 has been amended to recite "an electronic version" to overcome the noted rejection. Reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. §112, second paragraph are respectfully requested.

Rejections under 35 U.S.C. § 103

The Examiner rejects claims 1, 13-17, 21, 22, 34-38, 47, and 50 under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view GOOGLE1. Applicant

respectfully traverses.

A proper rejection under 35 U.S.C. § 103 requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest each and every claim limitation. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The cited combination of THOMSON and GOOGLE1 do not disclose or reasonably suggest the combination of features recited in Applicant's claims 1, 13-17, 21, 22, 34-38, 47, and 50, as amended.

Independent claim 1, as amended, recites a computer-implemented method. The method includes storing in a searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items; storing an index representing information included in a plurality of web documents; receiving a search query; searching the index for web documents that are relevant to the search query; searching the data sets in the electronic database for data sets representing printed items that are relevant to the search query; generating an integrated ranked listing comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items; and for said at least one of

the relevant printed items, providing an electronic reference for accessing further information. The cited combination of THOMSON and GOOGLE1 do not disclose or reasonably suggest the combination of features recited in Applicant's claim 1.

For example, neither THOMSON nor GOOGLE1 disclose or suggest generating an integrated ranked listing comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items, as recited in amended claim 1. It should be noted that the above-recited feature has been added to claim 1 by way of the present amendment. However, subject matter similar to this feature was originally recited in claim 20. In rejecting original claim 20, the Examiner acknowledged that the combination of THOMSON and GOOGLE1 fails to disclose ranking characterizations of the relevant web pages and of the relevant publication items (Office Action, pg. 26). For at least this reason alone, Applicant submits that claim 1 is patentable over the cited combination of THOMSON and GOOGLE1. In the interests of expeditious prosecution, Applicant hereby addresses a potential rejection of amended claim 1 based on the current rejection of claim 20. Accordingly, it is noted that in remedying the noted deficiency, with respect to the disclosures of THOMSON and GOOGLE1, the Examiner relied upon col. 8, lines 63-67 of KINCAID et al. for allegedly disclosing the ranking of relevant web pages and publication items. Applicant respectfully disagrees with this interpretation of KINCAID et al.

Col. 8, lines 61-67 of KINCAID et al. discloses:

> The documents are grouped according to a search engine that is being used and may appear with predefined relevance rankings, if any, according to schemes used

> by that particular search engine. That is, the results are listed in the order that they appear with regard to each particular search engine. In some cases, like Google, the results may be listed in an order corresponding to some scheme for relevancy ranking.

This section of KINCAID et al. discloses that search results returned in a metasearch (i.e, a search conducting using multiple search engines) may be grouped and ranked in the manner grouped and ranked by the respective search engine. This section of KINCAID et al. does not disclose searching web documents and data sets representing printed items from publications respectively printed by a plurality of respective publishers, as required by claim 1. Moreover, KINCAID et al. also does not disclose or suggest generating an integrated ranked listing comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items. In fact, KINCAID et al. does not disclose identifying at least one characterization of at of at least one of the relevant printed items, as recited in amended claim 1. Rather, KINCAID et al. discloses maintaining, grouping, ordering, and ranking of search results based on the database from which they are obtained. For at least this reason, claim 1 is patentable over the cited combination of THOMSON and GOOGLE1, even considering the possible combination with KINCAID et al., as presented with respect to original claim 20. In view of the above amendments and the preceding remarks, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Claims 13-17 depend from claim 1 and are patentable over the cited combination of THOMSON and GOOGLE1 for at least the reasons set forth above, with respect to claim 1. Moreover, in the event that the Examiner applies KINCAID et al. in the manner

described above, Applicant respectfully submits that claims 13-17 are patentable over the combination of THOMSON, GOOGLE1, and KINCAID et al. for at least the reasons set forth in the above arguments. Accordingly, reconsideration and withdrawal of the rejection of claims 13-17 are respectfully requested.

Independent claim 21 includes subject matter similar to, yet possibly different in scope than claim 1. Accordingly, claim 21 is patentable over the cited combination of THOMSON and GOOGLE1, as well as the implied combination of THOMSON, GOOGLE1, and KINCAID et al, for at least reasons similar to those set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 21 is respectfully requested.

Independent claim 22 recites a computer-implemented arrangement including a search engine and a searchable electronic database, the computer-implemented arrangement adapted to respond to Internet-based search queries. The arrangement includes a memory bank and a first programmable computer node, the memory bank and the programmable computer node being adapted to store the searchable database as data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items and information representing an advertisement printed with the at least one of the printed items; and a second programmable computer node including the search engine, the second programmable computer node adapted to search for web pages that are relevant for a search query and to search the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying relevant Internet web pages and

relevant data sets corresponding to relevant printed items, and to return at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant printed items and, for said at least one of the relevant printed items, to provide the information representing an advertisement for said at least one of the relevant printed items. The cited combination of THOMSON and GOOGLE1 do not disclose or reasonably suggest the combination of features recited in Applicant's claim 22.

For example, neither THOMSON nor GOOGLE1 disclose or suggest that each data set includes information representing an advertisement printed with the at least one of the printed items, and, for the at least one of the relevant printed items, provide the information representing an advertisement for the at least one of the relevant printed items. THOMSON and GOOGLE1 are completely silent with respect to the feature of providing advertisement information in each data set representing printed items or providing information relating to the advertisement with identified relevant characterizations of at least one relevant printed item. For at least this reason claim 22 is patentable overt the cited combination of THOMSON and GOOGLE1.

It should be noted, however, that the above-recited features have been added to claim 22 by way of the present amendment. Subject matter similar to these features was originally recited in claims 4 and 8. In rejecting original claims 4 and 8, the Examiner acknowledged that the combination of THOMSON and GOOGLE1 did not disclose storing data sets representing advertisements printed with the printed items (Office Action, pp. 13-14). In the interests of expeditious prosecution, Applicant hereby

addresses a potential rejection of amended claim 22 based on the currently pending rejection of claims 4 and 8. Accordingly, it is noted that in remedying the noted deficiency, with respect to the disclosures of THOMSON and GOOGLE1, the Examiner relied upon cols. 2-3, lines 59-5 of SMITH for allegedly disclosing storing data sets representing advertisements printed with the printed item (Office Action, pg. 13). Applicant respectfully disagrees with this interpretation of SMITH.

Cols. 2-3, lines 59-5 of SMITH discloses:

> The retailer can add, update, and delete information about advertisements in the retail self-service terminal database. Adding information about an advertisement consists of specifying: (1) a description of the advertisement; (2) a time value, in seconds, that defines how long the ad should appear; (3) a uniform resource locator (URL) defining the content that appears when a consumer interacts with the ad that is displayed; (4) a weighting factor that is used to determine the number of successive times the ad should be displayed within an attract loop; (5) a URL defining the actual advertisement content; and (6) an advertisement media type (for example, GIF image, MPEG video, ASF streaming video, and so forth).

This section of SMITH discloses that advertisement information may be updated to include various elements, such as a description time of display, URL, media, etc. This section of SMITH does not disclose storing a data set relating to printed items, where the data set includes information representing an advertisement printed with the at least one of the printed items, and, for the at least one of the relevant printed items, provide the information representing an advertisement for the at least one of the relevant printed items. In fact, SMITH does not disclose advertisements associated with printed items at all. Rather, the advertisements of SMITH appear to be web-specific advertisements created for display to customers in a self-service retail environment. Absent some additional suggestion in SMITH, it is unclear how the web or server-based

advertisements of SMITH disclose or suggest the storage of advertisements in data sets associated with printed items, and, for the at least one of the relevant printed items, provide the information representing an advertisement for the at least one of the relevant printed items, as required by claim 22. For at least this reason, claim 22 is patentable over the implicit combination of THOMSON, GOOGLE1, and SMITH previously applied to claims 4-9 and 25-30. Reconsideration and withdrawal of the rejection of claim 22 is respectfully requested.

Claims 34-38 depend from claim 22. Accordingly, claims 34-38 are patentable over both the cited combination of THOMSON and GOOGLE1 as well as the implied combination of THOMSON, GOOGLE1, and SMITH for at least the reasons set forth above, with respect to claim 22. Accordingly, reconsideration and withdrawal of the rejection of claims 34-38 are respectfully requested.

Independent claim 47 includes subject matter similar to, yet possibly different in scope than claim 1. Accordingly, claim 47 is patentable over the cited combination of THOMSON and GOOGLE1, as well as the implied combination of THOMSON, GOOGLE1, and KINCAID et al, for at least reasons similar to those set forth above, with respect to claim 1. Accordingly, reconsideration and withdrawal of the rejection of claim 47 is respectfully requested

Independent claim 50 has been canceled without prejudice or disclaimer. Accordingly, withdrawal of the rejection of claim 50 is respectfully requested.

Claims 2, 3, 23, 24, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1 and further in view of BAXTER et

al. Applicant respectfully traverses.

Claims 2 and 3 depend from claim 1. The disclosure of BAXTER et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Accordingly, claims 2 and 3 are patentable over the cited combination of THOMSON, GOOGLE1, and BAXTER et al., for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 2 and 3 are respectfully requested.

Claims 23 and 24 depend from claim 22. The disclosure of BAXTER et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 22. Accordingly, claims 23 and 24 are patentable over the cited combination of THOMSON, GOOGLE1, and BAXTER et al., for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 23 and 24 are respectfully requested.

Claims 48 and 49 depend from claim 47. The disclosure of BAXTER et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 47. Accordingly, claims 48 and 49 are patentable over the cited combination of THOMSON, GOOGLE1, and BAXTER et al., for at least the reasons set forth above, with respect to claim 47. Reconsideration and withdrawal of the rejection of claims 48 and 49 are respectfully requested.

Claims 4-9 and 25-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of SMITH. Applicants respectfully traverse.

Claims 4-9 depend from claim 1. The disclosure of SMITH does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Accordingly, claims 4-9 are patentable over the cited combination of THOMSON, GOOGLE1, and SMITH, for at least the reasons set forth above, with respect to claim 1. Moreover, these claims recited additional features neither disclosed nor suggested by the cited combination of THOMSON, GOOGLE1, and SMITH.

For example, claim 4 recites that storing data sets representing the advertisements includes storing information for linking to information about a product represented in one of the advertisements. THOMSON, GOOGLE1, and SMITH do not disclosure or reasonably suggest this feature. In rejecting claim 4, the Examiner acknowledged that the combination of THOMSON and GOOGLE1 did not disclose storing data sets representing advertisements printed with the printed items (Office Action, pp. 13-14). To remedy this noted deficiency, with respect to the disclosures of THOMSON and GOOGLE1, the Examiner relied upon cols. 2-3, lines 59-5 of SMITH for allegedly disclosing storing data sets representing advertisements printed with the printed item (Office Action, pg. 13). Applicant respectfully disagrees with this interpretation of SMITH.

Cols. 2-3, lines 59-5 of SMITH (recited above) discloses that advertisement information may be updated to include various elements, such as a description time of display, URL, media, etc. This section of SMITH does not disclose storing a data set relating to printed items, where the data set includes information representing an advertisement printed with the at least one of the printed items. In fact, SMITH does not

disclose advertisements associated with printed items at all. Rather, the advertisements of SMITH appear to be web-specific advertisements created for display to customers in a self-service retail environment. Absent some additional suggestion in SMITH, it is unclear how the web or server-based advertisements of SMITH disclose or suggest the storage of advertisements in data sets associated with printed items. For at least this additional reason, claim 4 is patentable over the combination of THOMSON, GOOGLE1, and SMITH. Reconsideration and withdrawal of the rejection of claim 4 is respectfully requested.

Claim 8 recites storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items and wherein returning at least one characterization of at least one of the relevant printed items includes returning information from a data set representing an advertisement for said at least one of the relevant printed items. THOMSON, GOOGLE1, and SMITH do not disclosure or reasonably suggest this feature. In rejecting claim 8, the Examiner again relied upon cols. 2-3, lines 59-5 of SMITH for allegedly disclosing storing data sets representing advertisements printed with the printed item (Office Action, pg. 15). Applicant respectfully disagrees with this interpretation of SMITH.

As described above, the cited section of SMITH discloses web or server-based advertisements viewing in a self-service retail environment. As disclosed, the advertisement information of SMITH may be updated to include various elements, such as a description time of display, URL, media, etc. However, the cited section of SMITH makes no disclosure whatsoever relating to the returning at least one characterization of

at least one of the relevant printed items including returning information from a data set representing an advertisement for said at least one of the relevant printed items, as required by claim 8. On the contrary, SMITH is not related to providing advertisements with respect to search results whatsoever and merely provides updatable, flexibly advertising in a retail environment. For at least this additional reason, claim 8 is patentable over the cited combination of THOMSON, GOOGLE1, and SMITH. Reconsideration and withdrawal of the rejection of claim 8 are respectfully requested.

Claims 25 and 29 have been canceled without prejudice or disclaimer. Accordingly, withdrawal of the rejections of these claims are respectfully requested.

Claims 26-28 and 30 depend from claim 22. The disclosure of SMITH does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Moreover, claim 22, as amended is patentable over the combination of THOMSON, GOOGLE, and SMITH for the reasons set forth in detail above. Accordingly, claims 26-28 and 30 are patentable over the cited combination of THOMSON, GOOGLE1, and SMITH, for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 26-28 and 30 are respectfully requested.

Claims 10, 31 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of MITCHELL et al. Applicant respectfully traverses.

Claim 10 depends from claim 1. The disclosure of MITCHELL et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above,

with respect to claim 1. Accordingly, claim 10 is patentable over the cited combination of THOMSON, GOOGLE1, and MITCHELL et al., for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 10 are respectfully requested.

Claims 31 and 42 depend from claim 22. The disclosure of MITCHELL et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 22. Accordingly, claims 31 and 42 are patentable over the cited combination of THOMSON, GOOGLE1, and MITCHELL et al., for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 31 and 42 are respectfully requested.

Claims 11, 12, 32 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view GOOGLE1, in view of MITCHELL et al., and further in view of BAXTER et al. Applicant respectfully traverses.

Claims 11 and 12 depends from claim 1. The disclosures of MITCHELL et al. and BAXTER et al. do not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Accordingly, claims 11 and 12 are patentable over the cited combination of THOMSON, GOOGLE1, MITCHELL et al., and BAXTER et al. for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 11 and 12 are respectfully requested.

Claims 32 and 33 depends from claim 22. The disclosures of MITCHELL et al. and BAXTER et al. do not remedy the deficiencies in the disclosures of THOMSON and

GOOGLE1 noted above, with respect to claim 22. Accordingly, claims 32 and 33 are patentable over the cited combination of THOMSON, GOOGLE1, MITCHELL et al., and BAXTER et al. for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 32 and 33 are respectfully requested.

Claims 18 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of CRAGUN et al. Applicant respectfully traverses.

Claim 18 depends from claim 1. The disclosure of CRAGUN et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Accordingly, claim 18 is patentable over the cited combination of THOMSON, GOOGLE1, and CRAGUN et al., for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 18 are respectfully requested.

Claim 39 depends from claim 22. The disclosure of CRAGUN et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 22. Accordingly, claim 39 is patentable over the cited combination of THOMSON, GOOGLE1, and CRAGUN et al., for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claim 39 are respectfully requested.

Claims 19 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of GOOGLE2. Applicant

respectfully traverses.

Claim 19 depends from claim 1. The disclosure of GOOGLE2 does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Accordingly, claim 19 is patentable over the cited combination of THOMSON, GOOGLE1, and GOOGLE2, for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 19 are respectfully requested.

Claim 40 depends from claim 22. The disclosure of GOOGLE2 does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 22. Accordingly, claim 40 is patentable over the cited combination of THOMSON, GOOGLE1, and GOOGLE2, for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claim 40 are respectfully requested.

Claims 20 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of GOOGLE1, and further in view of KINCAID et al. Applicant respectfully traverses.

Claim 20 depends from claim 1. The disclosure of KINCAID et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 1. Accordingly, claim 20 is patentable over the cited combination of THOMSON, GOOGLE1, and KINCAID et al., for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 20 are respectfully requested.

Claim 41 depends from claim 22. The disclosure of KINCAID et al. does not remedy the deficiencies in the disclosures of THOMSON and GOOGLE1 noted above, with respect to claim 22. Accordingly, claim 41 is patentable over the cited combination of THOMSON, GOOGLE1, and KINCAID et al., for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claim 41 are respectfully requested.

Claims 43 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of BAXTER et al. Applicant respectfully traverses.

Independent claim 43 recites an arrangement for maintaining an electronic database that is searchable via a search engine in response to Internet-based search queries. The arrangement includes means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items, wherein the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product; with each stored data set representing printed items from publications, means for recording whether the respective publisher has authorized display of the printed item; means, responsive to a search query and including the search engine, for searching for web pages that are relevant for the search query and searching the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant publication items; means for returning at least one characterization of at least one of the

relevant web pages and at least one characterization of at least one of the relevant publication items and, for said at least one of the relevant publication items for which the respective publisher has authorized display, providing an electronic path for accessing a copyrighted version thereof, wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items. The cited combination of THOMSON and BAXTER et al. do not disclose or suggest each and every feature of claim 43, as amended.

For example, the combination of THOMSON and BAXTER et al. do not disclose or reasonably suggest the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product, and wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items, as recited in claim 43. THOMSON and BAXTER et al. are completely silent with respect to the feature of providing advertisement information in each data set representing printed items or providing information relating to the advertisement with identified relevant characterizations of at least one relevant printed item. For at least this reason claim 43 is patentable overt the cited combination of THOMSON and BAXTER et al..

It should be noted, however, that the above-recited features have been added to claim 43 by way of the present amendment. Subject matter similar to these features was originally recited in claims 4 and 8. In rejecting original claims 4 and 8, the Examiner

acknowledged that THOMSON does not disclose storing data sets representing advertisements printed with the printed items (Office Action, pp. 13-14). In the interests of expeditious prosecution, Applicant hereby addresses a potential rejection of amended claim 43 based on the disclosure of SMITH as applied to claims 4 and 8. Accordingly, it is noted that in remedying the noted deficiency in THOMSON, the Examiner relied upon cols. 2-3, lines 59-5 of SMITH for allegedly disclosing storing advertisements printed with the printed item (Office Action, pg. 13). Applicant respectfully disagrees with this interpretation of SMITH.

As discussed above, columns 2-3, lines 59-5 of SMITH discloses that advertisement information may be updated to include various elements, such as a description time of display, URL, media, etc. This section of SMITH does not disclose storing a data set relating to printed items, where the data set includes an advertisement printed with the at least one of the printed items, and, for the at least one of the relevant printed items, provide the information representing an advertisement for the at least one of the relevant printed items. In fact, SMITH does not disclose advertisements associated with printed items at all. Rather, the advertisements of SMITH appear to be web-specific advertisements created for display to customers in a self-service retail environment. Absent some additional suggestion in SMITH, it is unclear how the web or server-based advertisements of SMITH disclose or suggest the storage of advertisements in data sets associated with printed items, and, for the at least one of the relevant printed items, provide the information representing an advertisement for the at least one of the relevant printed items, as required by claim 43. For at least this reason, claim 43 is patentable

over the implicit combination of THOMSON, BAXTER et al., and SMITH. Reconsideration and withdrawal of the rejection of claim 43 is respectfully requested.

Independent claim 45 has been canceled without prejudice or disclaimer. Accordingly, withdrawal of the rejection of claims 45 is respectfully requested.

Claims 44 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over THOMSON in view of BAXTER et al., and further in view GOOGLE1. Applicant respectfully traverses.

Claims 44 and 46 have been canceled without prejudice or disclaimer. Accordingly, withdrawal of the rejection of claims 44 and 46 is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Amendments to the Drawings:

Subject to approval from the Examiner, please replace drawings sheet labeled Fig. 2A and Fig. 2B, with the attached replacement drawing sheet. The drawings have been amended to correct a reference number error, as requested by the Examiner.